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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,295	12/11/2000	George Bradley Hobbs	10003974-1	3877

7590 03/31/2006  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O.Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/734,295	HOBBS, GEORGE BRADLEY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Saeid Ebrahimi-dehKordy	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-21 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response to Arguments**

1. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection. Examiner is not convinced by the applied affidavit provided by the applicant (declaration of prior invention under 37 C.F.R. 1.131, filed on 1/4/06) to overcome the prior art applied on the last office action, the conception of the subject matter presented on the claims is moot according to the affidavit presented by the applicant, However Examiner would request that applicant points out exactly on the document provided were the conception lies in relation with the claims presented.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 13-20, 24-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Markowitz (U.S. patent 5,513,254)

**Regarding claim 11 and 19** Markowitz discloses: A method of processing a print job of a customer and including advertising with the print job; the method comprising the steps of: defining a print processing system controller having a plurality of advertisements registered therewith (note Fig.3 column 6 lines 20-33, where the advertisements are stored in the server 111) defining a network communication link between the customer and the print processing system controller (note Fig.1 items 119 and 105 where the user is connected to the recipient through these links) receiving a

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data file for the print job from the customer at the print processing system controller via the network communication link (note Fig.1, column 2 lines 56-67 where the fax is transmitted by the user to the server 111 for addition of advertisements and processing) processing the data file for the print job and determining from the data file a content of the print job (note column 4 lines 2-5 where the advertisement are set to satisfy the facsimile's information) and associating at least one of the advertisements with the print job based on the data file for the print job (note column 3 lines 63-67 and column 4 lines 1-7) associating at least one of the advertisements with the print job including automatically selecting the at least one of the advertisements based on the content of the print job and the profile of the advertisements (note column 6 lines 20-32 where the advertisements are automatically chosen based on the facsimile number of the recipients or the suitability of the of the user).

Regarding claim 13 Markowitz discloses: The method of claim 11, wherein the step of associating the at least one of the advertisements includes associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (note column 6 lines 20-33)

Regarding claim 14 Markowitz discloses: the method of claim 11 , further comprising the step of : printing the print job , and wherein the step of associating the at least one of the advertisements includes printing the at least one of the advertisements with the print job (note column 1 lines 65-67 and column 2 lines 1-11).

Regarding claim 15 Markowitz discloses: The method of claim 14, wherein the step of associating the at least one of the advertisements includes querying the

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customer for approval of associating the at least one of the advertisements with the print job and receiving a response thereto, and wherein printing the at least one of the advertisements includes printing the at least one of the advertisements with the print job if the response is favorable (note column 6 lines 16-54).

Regarding claim 16 Markowitz discloses: The method of claim 11, further comprising the step of: registering the advertisements with the print processing system Controller (note column 3 lines 48-49).

Regarding claim 17 Markowitz discloses: The method of claim 16, wherein the step of defining the network communication link includes defining the network communication link between at least one advertiser, the customer, and the print processing system controller and wherein the step of registering the advertisements includes registering at least one advertisement of the at least one advertiser with the print processing system controller via the network communication link (note column 6 lines 16-33).

Regarding claim 18 Markowitz discloses: The method of claim 16, wherein the step of registering the advertisements includes storing the advertisements and wherein the step of associating the at least one of the advertisements includes retrieving the at least one of the advertisements (note column 3 lines 48-55 and column 6 lines 20-30).

Regarding claim 20 Markowitz discloses: The system of claim 19, wherein the print processing system controller is configured to communicate with the customer via network communication link; and wherein the print processing system controller is

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adapted to receive the data file for the print job from the customer via the network (note column 6 lines 20-54).

Regarding claim 24 Markowitz discloses: The method of claim 19, wherein the step of associating the at least one of the advertisements includes associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (note column 6 lines 20-33)

Regarding claim 25 Markowitz discloses: The method of claim 19, wherein the step of associating the at least one of the advertisements includes querying the customer for approval of associating the at least one of the advertisements with the print job and receiving a response thereto, and wherein printing the at least one of the advertisements includes printing the at least one of the advertisements with the print job if the response is favorable (note column 6 lines 16-54).

Regarding claim 26 Markowitz discloses: The method of claim 19, wherein the step of defining the network communication link includes defining the network communication link between at least one advertiser, the customer, and the print processing system controller; and wherein the step of registering the advertisements includes registering at least one advertisement of the at least one advertiser with the print processing system controller via the network communication link (note column 6 lines 16-33).

Regarding claim 28 Markowitz discloses: The system of claim 19, further comprising: a print processing data storage system configured to communicate with the print processing system controller and store the advertisements therein (note column 3 lines 48-50).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz (U.S. patent 5,513,254) in view of Henry (U.S. patent 6,424,426)

Regarding claim 12 and 21 and 27 Markowitz does not clearly disclose: The method of claim 1, wherein the step of defining the network communication link includes defining an Internet communication link between the customer and the print processing system controller. On the other hand Henry discloses: defining the network communication link includes defining an Internet communication link between the customer and the print processing system controller (note column 2 lines 6-67 and column 3 lines 1-3). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Markowitz's invention according to the teaching of Henry, where Henry in the same filed of endeavor teaches the way the facsimile is connected through the Pop to be transmitting over the internet.

**Contact Information**

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

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The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark

**"EXPEDITED PROCEDURE"**)

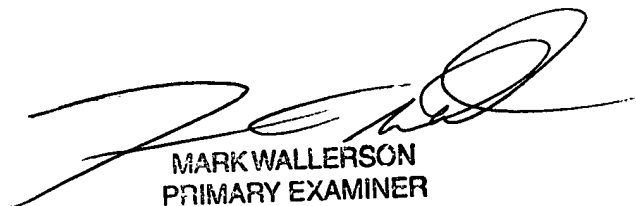
**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label "PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2626  
March 26, 2006



MARK WALLERSON  
PRIMARY EXAMINER